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10/775,368	02/10/2004	Edward J. Stashluk JR.	067439.0161	9915
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BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			NGUYEN, THUY-VI THI	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/775,368	Applicant(s) STASHLUK ET AL.	
	Examiner THUY-VI NGUYEN	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/09</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on 11/19/09 wherein:
Claims 1-32 are currently pending;
Claims 1, 14, and 28 have been amended;

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claim 1, step 5 recites using a computer operated by the merchant or a specialized returns center to correlated the item data, transaction data, customer data and package data with set of stored business rules to determine coding to be printed on a return shipping label; where in the set of stored business rules specify how packages are to be shipped.....the returns center “; and step 6 recites generating the shipping label included a third party machine readable code, where in the data in the third party machine readable code include the results of the correlating step (which is item data, transaction data, customer data and package data) and represents at least shipping origin of the package and identification of the transaction; However it is unclear how the information of shipping origin of the package and identification of the transaction" is included in the machine readable code since this information is not correlated with a set

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of stored business rules to determine coding to be printed on a return shipping label as indicated in the previous step (step 5). The only information/data correlated with the set of stores business rules is the broadly recited item data, transaction data, customer data and package data.

Further in claim 1, step (6) Applicant recites "the data represented by the machine readable code includes the results of the correlating step and represents at least a shipping origin of the package and identification of the transaction". It is not clear if the machine readable code includes both the results of the correlating step and the shipping origin of the package and identification of the transaction or if the code includes the result of the correlating step which represents shipping origin of the package and identification of the transaction?. It appears in the specification that the machine readable code includes "shipping origin of the package and identification of the transaction" {see pars. 0059-0063, Application Publication). However, when discussing correlation, the code appears to be used to correlate the return item to the transaction or to the merchant business rule, but not to include the results of the correlation. {see pars. 0052, 0064, Application Publication).

As a result, it is not clear what is the relationship between the set of stored business rules and the content of the machine readable code.

2) Claim 1, " a third party machine readable code" in the shipping label is generated by the merchant or the returns center as recites in step 6 (claim 1). Is the third party preferred to merchant entity, or returns center entity or carrier entity or customer as recited in the claim?

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3) Claim 14 and 28 are rejected for the same reason sets forth the rejected claim 1 above.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims **1-32** are rejected under 35 U.S.C. 103(a) as being unpatentable over TSUNENARI ET AL (US 2002/0013744) in view of RAMING (US 6,616,189).

As for claim 1, Tsunenari et al. discloses a computer-implemented method of providing merchandise return labels for enabling a customer to ship a package containing one or more items previously acquired from a merchant during a transaction, comprising the steps of:

- 1) accessing item data representing at least one detail about the item

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{see at least figures 9-10g; 10i; pars. 0013; 0075, lines 1-23 discloses information about the product/item to be returned}

2) accessing transaction data representing at least one detail about the transaction associated with the item;

{see at least figures 4, 10G, 10K; pars.0034; 0075; 0083 disclose product transaction associate with the item}

3) accessing customer data representing at least one detail about a customer associated with the transaction

{see at least figures 10C, 10G, 10I, 10K; and pars. 0072, 0075, 0080-0081

4) accessing package data representing at least one detail about the package in which the item is expected to be shipped

{see at least figures 10I; 0061; 0116 discloses shipping package data}

5) using a computer operated by the merchant/manufacture from whom the item was acquired to correlate the item data, transaction data, customer data, with a set of stored business rules to determine coding to be printed on a return shipping label; wherein the set of stored business rules specify how packages are to be shipped from the customer to a returns center and represent guidelines for determining choice of carrier, shipping destination, shipping rate, and package disposition for shipment from the customer to the returns center

{see figures 1-3; pars. 0060-0063; 0080-0081; 0092-0094 discloses the merchant/manufacture web server correlate the returned product information and customer information using the business rules to determine the coding to be printed on

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a return shipping label, e.g. based on the receiving particular returned product information from customer, *the server will determine the destination of the product in accordance with the product type sending the product to a facility at which it may be processed. the destination is defined in accordance with the location of the customer, selecting whatever suitable destination is closest to customer in order to minimize cost* (par. 0060); *determine which carrier service is the most economical, given the nature of the product to be returned (such as its weight and dimension) and the pickup delivery points* (par. 0061); *Once the destination and a carrier service are selected, the Web server generates shipping label data. The shipping label include data sufficient for the client/consumer computer to direct a printer to print a shipping label that includes an identification of the destination and the carrier service selected, and also data necessary to print an actualization code on the label* (par. 0062-0063); *and the selection of the product destination is made by the manufacturer server on the basis of specified rules that take into consideration the geographical location of the customer and the nature of the product being returned* (see pars. 0092-0093)}.

6) using the computer operated by the merchant/manufacture from whom the item was acquired to generate a third party machine readable code for the return shipping label for shipment from the customer to the return center (return facility),

{see figures 10I; pars. 0062-0063; 0081 discloses generating the shipping label as the results of the correlating step (recited item data, transaction data, customer data and package data), and the label also includes the machine readable code which contain information used by the carrier for the pick up and tracking of the parcel};

7) using the computer operated by the merchant/manufacture web server to format the return shipping label and complies with shipping labels specification of the choice of carrier, the shipping label include the machine readable code presents on the shipping label specifies the third party/carrier

{see figure 10I; 10J, pars. 0061; 0081-0082 discloses the formatting the returning shipping label include the third party machine readable code, and the shipping label also complies with shipping label specifications of the choice of carrier by (determine which carrier service is the most economical, given the nature of the product to be returned, and the pick up and delivery points)}.

Note: for convenience, numbers (1)-(7) are added to the beginning of each step.

Tsunenari et al discloses the claimed invention as indicated above except for the type of information/data in the machine readable code includes the results of the correlating (item data, transaction, customer data and package data) and represents at least shipping origin of the package and identification of the transaction.

RAMING discloses the well know feature of the return shipping label containing a machine readable code represents information about *purchase order number, control order number, return address and a returned item/product authorization code number* {see figure 8, discloses return label 18A, with the a bar code (164); col. 6, lines 46-55}. This would facilitate the return of the merchandise {see col. 6, lines 35-45} and inherently facilitate the identifying the internal transaction which represents the returning product information and also for security purpose as well as protecting personal information.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to providing the teachings of TSUNENARI ET AL to include the bar code containing information such as purchase order, control order number, return address, returned item as taught by RAMING for facilitating the return of the merchandise and or other benefits as shown above.

As for dep. claims 2-10 which discloses the information/data about the items and the transaction, customer information, package information, this is fairly taught in TSUNENARI ET AL {see figures 10G-10, and figures 14-15; pars. 0060-0063; 0075}.

As for claims 11-13, which discloses accessing the information such as shipping information, carrier center location information, mail information, this is fairly taught in TSUNENARI ET AL {see figures 10G-10, and figures 14-15; pars. 0060-0063; 0075}

Note: As for the “data or information” recites in dep. 2-13, this information have been determined to be non-functional descriptive material (NFDM) because the information does not “impart functionality when employed as a computer component”, thus having no patentable weight. See MPEP 2106.01 “Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material.” In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship

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among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) “Nonfunctional descriptive material” includes but is not limited to music, literary works, and a compilation or mere arrangement of data.

As for independent claim 14, which discloses software embodied in a memory and comprising programming operable when executed by a computer to carry the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim as stated above.

As for dep. claim 15, which discloses the accessing the group of information/data such as item data, customer data, transaction data via a remote data communication link, this is fairly taught in TSUNENARI ET AL {see figures 10G-10I, and figures 14-15; pars. 0060-0063; 0075}

As for dep. claims 16-18, which discloses the access shipping information include the shipping rate, and carrier location data and mail data , this is fairly taught in TSUNENARI ET AL {see figures 10G-10, and figures 14-15; pars. 0060-0063; 0075}

As for dep. claims 19-27, basically these claims carry the similar steps as for the dep. claims 2-10 above. They are rejected for the same reason sets forth the dep. Claims 2-10 as stated above.

As for independent claim 28, which discloses a software embodied in a memory and comprising programming operable when executed by a computer to carry

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the method steps of the independent claim 1. Therefore, is rejected for the same reason sets forth the independent claim as stated above.

As for dep. claim 29, TSUNENARI ET AL discloses a business rules is used to correlate customer data and access customer data representing at least one detail about a customer associated with the transaction, {see figures 0075; 0080-0082; 0092-0093}

As for claim 30, TSUNENARI ET AL discloses a business rules is used to access package data representing at least one detail about the package in which item is expected to be shipped {see figures 10G-10I; pars. 0075; 0080-0082; 0092-0093}

AS for dep. claims 31-32, TSUNENARI ET AL discloses the shipping information include the choice of carrier and package information, {see figures 10G-10I; pars. 0060-0063; 0080-0081. 0092-0093}

Response to Arguments

5. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689
3/8/10